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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,550	04/01/2004	Lydia Chase	14622-026001	7158
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			EXAMINER	
			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3694	
			NOTIFICATION DATE	DELIVERY MODE
			05/29/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/815,550

Applicant(s)

CHASE ET AL.

Examiner

MARY CHEUNG

Art Unit

3694

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 and 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the RCE filed on February 26, 2009. Claim 1-35 are pending. Claims 17-23 and 32-35 are withdrawn. Claims 1-16 and 24-31 are examined below.

Response to Arguments

2. After carefully reviewed the affidavit filed on February 26, 2009, the examiner has withdrawn prior art rejection by HomeTracker Lender Center. However, the claims are subject to new grounds of rejections.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-16 recite method directed to purely mental steps. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Thus, to qualify as a statutory process, the

claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 8-12, 24-25 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Gendler, US 7,321,864 B1.

As to claim 1, Gendler teaches a method for submitting requests for approval relating to management of real property, the method comprising (column 1 lines 44-51):

- presenting, on a user interface, a form for receiving data from a user, with the data relating to at least one request that further relates to management of real property (column 7 lines 53-62 and Figs. 3-4);
- receiving an indication of at least one request for approval, with the indication received through a user interaction with the form presented on the user interface (column 8 lines 3-30);

- identifying, tier each request, at least one type of data item to be provided by the user, wherein the at least one type of data item identified for each request is based on a type associated with the request (column 8 lines 3-30); and
- displaying, on the form, an indication of the at least one type of data item for each request (column 8 lines 3-37).

As to claim 2, Gendler teaches wherein each request for approval comprises a request for approval to perform a service and the type associated with the request comprises an identity of the service (Figs. 4-5).

As to claim 3, Gendler teaches wherein the user interaction with the form presented on the user interface comprises a user selection of at least one service from a menu of possible services (Figs. 2-5).

As to claim 4, Gendler teaches wherein the menu comprises a pull-down menu (column 8 lines 23-25).

As to claim 5, Gendler teaches wherein the services in the menu of possible services are customizable in accordance with requirements of an owner of the real property (Figs. 2-5 and associated text).

As to claim 8, Gendler teaches wherein the approval relates to a reimbursement of costs associated with the services, with the reimbursement provided by the receiving entity to the managing entity (Fig. 12 and associated text).

As to claim 9, Gendler teaches the at least one type of data item is selected from a predefined set of data item types identified on the form (column 8 lines 17-25).

As to claim 10, Gendler teaches the form includes, for each service, a data entry field for each type of data item in the predefined set of data item types and the indication of the at least one type of data item for each service comprises an indication of the data entry fields to be completed by the user (Fig. 5).

As to claim 11, Gendler teaches the predefined set of data item types include at least one of a quantity, a size, an explanation, or a cost (column 9 lines 55-57 and Fig. 6).

As to claim 12, Gendler teaches the predefined set of data items are customizable in accordance with requirements of an owner of the real property (column 9 lines 55-57 and Fig. 6).

Claims 24-25 and 28-29 are rejected for the same rationale as used in claims 1-2 and 9-10.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-7, 13 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendler, US 7,321,864 B1.

As to claims 6-7 and 26, Gendler discloses the claimed invention, as discussed above, except for the services relate to preservation and protection of the real property, and wherein the preservation and protection of the real property relate to a conveyance

of the real property to a receiving entity different from a managing entity that manages the preservation and protection. It would have been an obvious matter of design choice to modify the teachings of Gendler to perform services including relate to preservation and protection of real property. Since the applicant has not disclosed that service relate to preservation and protection of real property solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Gendler will perform the invention as claimed by the applicant with any means, method, or product to service relate to preservation and protection of the real property.

As to claims 13 and 27, Gendler teaches allowing the user to create project details and allowing the project manager to create bid package including special instructions (see Figs. 4-5, 9 and associated text). Gendler does not specially teach the indication of the at least one type of data item includes an indication that the user is to provide a specified number of bids for the service, further comprising: allowing a submission of the form with less than the specified number of bids for the service; and allowing the user to subsequently retrieve the form and provide at least one additional bid. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow to the project details in Gendler's teaching to include restrictions for number of bids for better manage the information received that relate to the project (Examiner Note: the steps of "allowing" are intended uses or capabilities and

not positive limitations. See *In re Schreiber*, 44 USPQ 2d 1429, and *In re Collier*, 158 USPQ 266).

9. Claims 14-16 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendler, US 7,321,864 B1 in view of Official Notice.

As to claims 14 and 31, Gendler teaches receiving data items from the user; comparing each request and the corresponding data items received from the user with data relating to approval guidelines; and determining whether the request should be approved based on the comparison (column 8 lines 26-59). Gendler does not specially teach the determination process is automatic. The examiner takes Official Notice that it is well known in the art to determine whether to approve a request based on a comparison can be done automatically. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the determination process in Gendler's teaching to be done automatically for expedite the approval time.

As to claims 15-16 and 30, Gendler teaches submitting various types of information for request for approval (Figs. 4-6). Gendler does not specially teach each request for approval comprises a request for an extension to a deadline, and wherein the at least one type of data item is selected from a predefined set of data item types identified on the form and the predefined set of data item types includes at least one of a date and an explanation. The examiner takes Official Notice that it is well known in the art to request extension to a deadline, wherein the request including at least one of date and an explanation for the extension. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the request submitted in

Gendler's teaching to include a request for extension, and the request including at least one of date and explanation for the extension so that the user can better manage the project in case of unexpected events.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone numbers for the organization where this application or proceedings is assigned are as follows:

- | | |
|----------------|--|
| (571) 273-8300 | (Official Communications; including After Final Communications labeled "BOX AF") |
| (571) 273-6705 | (Draft Communications) |

Art Unit: 3694

/Mary Cheung/
Primary Examiner, Art Unit 3694
May 26, 2009